



Docket No. 491332000300

CERTIFICATE OF HAND DELIVERY

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Gwendolyn Peacher

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Clóvis Ryuichi NAKAIE et al.

Serial No.: 10/018,842

Filing Date: December 21, 2001

For: SYNTHESIS OF A NOVEL
PARAMAGNETIC AMINO ACID
DERIVATIVE (EPM-5) FOR LABELING
DIFFERENT MACROMOLECULES AND
SYSTEMS (as amended)

Examiner: Kamal A. Saeed

Group Art Unit: 1626

#608
416-03

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated March 13, 2003, Applicants elect to prosecute the claims of Group III, claims 6-12, with traverse.

The Examiner states that the pending claims do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. Specifically, the Examiner states pyrrolidine is the structural moiety that is common to Groups I-III, but this moiety can not be considered a special technical feature since it is known in the prior art.

The Examiner has incorrectly identified the technical feature that is common to Groups I-III. Applicants' claims are not directed to pyrrolidine compounds in general or to 2,2,5,5-tetramethylpyrrolidine-1-oxyl-3-amine-4-carboxylic acid (hereinafter POAC). As explained by applicants, POAC has been around for over three decades. See specification, page 1, lines 17-19. Applicants claims are directed to a novel POAC derivative containing a FMOC protecting group (to 2,2,5,5-tetramethylpyrrolidine-1-oxyl-3-(9-fluorenylmethyloxycarbonyl)-amine-4-carboxylic acid) (hereinafter FMOC-POAC), page 1, lines 20-24.

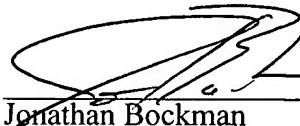
FMOC-POAC allows the insertion of POAC as a usual amino acid at any position of a peptide sequence. FMOC-POAC is novel compound that qualifies as a "special technical feature" shared by claims 4-12. Specifically, claim 4 claims FMOC-POAC, claim 5 claims an example of a molecule labeled using FMOC-POAC and claims 6-12 claim methods of labeling molecules using FMOC-POAC. Accordingly, since claims 4-12 all relate to the same general inventive concept, the restriction requirement should be withdrawn.

Applicant requests examination of the elected subject matter on the merits.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 491332000300.

Respectfully submitted,

Dated: April 14, 2003

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